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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte GRANVILLE R. FAIRCHILD, BILL FRISCHLING,
JOHN KEELING, DAN PACHECO, and MYRON ROSMARIN

_____

Appeal 2008-005500
Application 10/716,781
Technology Center 2100

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Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
JEAN R. HOMERE, *Administrative Patent Judges.*

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL [1]

_____

[1] The two-month time period for filing an appeal or commencing a civil
action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing,
as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE"
(paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery
mode) shown on the PTOL-90A cover letter attached to this decision.

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1, 2, 4, 5, 7, 8, 10, 11, and 13. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b). Claims 3, 6, 9, and 12 are objected to by the Examiner as being allowable if rewritten in independent format. The Examiner withdrew the rejections under 35 U.S.C. § 101 of claims 1, 7, and 13.

We affirm.

A. INVENTION

The invention at issue on appeal "relates to computer-driven data management systems. More particularly, the invention concerns a method and apparatus for performing an omnibus search providing a consolidated view of an online service subscriber's online and local data objects, and for conducting additional operations such as viewing, changing, and sharing the data objects." (Spec. 1).

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. 1. A method for operating an online service facility selectively accessed by multiple member computers, the online service facility including a plurality of online data centers operated by an online service provider (OSP) to store members' data objects relating to a variety of online services that the OSP renders to its members, the method comprising operations of:

providing an aggregated catalog that contains information including: (1) metadata identifying members' data objects residing in the data centers, and (2) metadata identifying

members' data objects residing in local storage of respective
member computers;

monitoring contents of the data centers to detect new
storage of prescribed types of data objects owned by the
members;

communicating with the member computers to identify
prescribed types of data objects newly stored in the member
computers' local storage;

updating the aggregated catalog to list the newly stored
data objects from the online data centers and member
computers' local storage;

responsive to each request by a member, searching the
aggregated catalog and utilizing results of the search to provide
an output for display at the requesting member's computer, the
output comprising a consolidated listing of both online data
objects and locally stored data objects owned by the requesting
member.

C. REFERENCES

The Examiner relies on the following references as evidence:

Kumamoto	US 5,805,858	Sept. 8, 1998
Johnson '384	US 5,878,384	Mar. 2, 1999
Johnson '839	US 5,964,839	Oct. 12, 1999
Hsiao	US 6,804,674 B2	Oct. 12, 2004

D. REJECTIONS

Claims 1, 4, 7, 10, and 13 stand rejected under 35 U.S.C. § 103(a) as
being unpatentable over Hsiao in view of Johnson '384).

Claims 2 and 8 stand rejected under 35 U.S.C. § 103(a) as being
unpatentable over Hsiao in view of Johnson '384 and in further view of
Kumamoto.

Claims 5 and 11 stand rejected under 35 U.S.C. § 103(a) as being
unpatentable over Hsiao in view of Johnson '384 and in further view of
Johnson '839.

II. ISSUE

Has the Examiner set forth a sufficient line of reasoning for the
conclusion of obviousness in the rejection of independent claim 1?
Specifically, has the Examiner made a showing of each of the limitations of
independent claim 1 with respect to the member and the member computer?

III. PRINCIPLES OF LAW
Obviousness under §103

"What matters is the objective reach of the claim. If the claim extends
to what is obvious, it is invalid under § 103." *KSR Int'l Co. v. Teleflex, Inc.*,
550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be
"more than the predictable use of prior art elements according to their
established functions." *Id.* at 417.

> Invention or discovery is the requirement which
> constitutes the foundation of the right to obtain a patent . . .
> unless more ingenuity and skill were required in making or
> applying the said improvement than are possessed by an
> ordinary mechanic acquainted with the business, there is an
> absence of that degree of skill and ingenuity which constitute
> the essential elements of every invention.

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Dunbar v. Myers, 94 U.S. 187, 197 (1876) (citing *Hotchkiss v. Greenwood*, 52 U.S. 248, 267 (1850)) (*Hotchkiss v. Greenwood* was cited with approval by the Supreme Court in *KSR*, 550 U.S. at 406, 415, 427).

Obviousness requires that all limitations be taught or suggested by the reference or references. 35 U.S.C. § 103(a).

IV. ANALYSIS

Appellants argue that "[b]y unfortunate coincidence, Hsiao contains a number of references to 'local' storage and 'local' components. However, the mere use of the terms 'local' and 'remote' cannot be taken on face value-as their meaning and content as used in Hsiao is completely different than the claimed invention." (Reply Br. 2). Appellants contend that Hsiao's use of the term "local" is inconsistent, and at any rate, unrelated to the data objects "residing in local storage of respective members computers" as recited in claim 1. We disagree with Appellants.

In the statement of the rejection at page 4 of the Answer the Examiner relies upon the teachings of Hsiao with respect to the scalable content manager of 515 manages the metadata stored in the data base 525 and the primary content stored in the local file system 530 or resource manager, providing an integrated function of both metadata management and data (primary content) management.

Appellants' main arguments appear in the Reply Brief where Appellants address each of the limitations of independent claim 1. Appellants contend that the arguments within the Examiner's Answer contradict each other. (Reply Br. 2). While we agree with Appellants that the Examiner's choice of wording appears self-contradictory, and we find

that it is in the Examiner's formulation of the rejection which causes that

appearance and find it to be another unfortunate coincidence for Appellants.

> Appellants contend that:

>> By unfortunate coincidence, Hsiao contains a number of references to "local" storage and "local" components. However, the mere use of the terms "local" and "remote" cannot be taken on face value-as their meaning and context as used in Hsiao is completely different than the claimed invention. Hsiao's "local" aspect refers to entities connected with a particular network or content management system rather than being "local" to a user's computer.

(Reply Br. 2). The Examiner states:

> Hsiao, column 1, lines 55-62, teaches a content management system as "[*i*]*n a content management system, three types of information are stored: primary content (also referred to as Data or Object), User Metadata, and System Metadata. Semi-structured and unstructured data, such as text file, image, web page, video clip, etc., constitute the primary content in a content management system. Description of, and information about the stored primary content, which are normally provided by the users, are referred to as user metadata*." Therefore, in light of the specification, the Examiner believes that an aggregate catalog is a content management system as taught in Hsiao. Furthermore, Hsiao teaches that content information including: (1) metadata identifying members' data objects ("*Description of, and information about the stored primary content, which are normally provided by the users, are referred to as user metadata*." The preceding text clearly indicates that the stored primary content is the data object and the description of, and information are the metadata identifying member's data object.)(column 1, lines 60-62) residing in the data centers (i.e. "*A scalable content management system manages searches from a local content manager <u>and</u> a plurality of remote content managers. A single scalable content manager manages data in a content repository or file system and its associated metadata in the same content repository or in a database, which will greatly simplify both content management logic and client application logic.*"

The preceding text clearly indicates that the data centers are the plurality of remote content managers)(Abstract), (2) metadata identifying members' data objects ("*Description of, and information about the stored primary content, which are normally provided by the users, are referred to as user metadata.*" The preceding text clearly indicates that the stored primary content is the data object and the description of, and information are the metadata identifying member's data object.)(column 1, lines 60-62) residing in the local storage of respective members computers (i.e. "*A scalable content management system manages searches from a local content manager and a plurality of remote content managers. A single scalable content manager manages data in a content repository or file system and its associated metadata in the same content repository or in a database, which will greatly simplify both content management logic and client application logic.*" The preceding text clearly indicates that the local storage of respective members computer is a local content manager.)(Abstract). Also, the Examiner cites Figure 6 of Hsiao to further illustrate the prior art's teaching of this particular limitation. Since it is clear that the scalable content manager searches both the local AND a plurality of remote content managers, Hsiao clearly teaches the limitations of providing an aggregate catalog that contains information including: (1) metadata identifying members' data objects residing in the data centers, and (2) metadata identifying members' data objects residing in the local storage of respective members computers.

(Ans. 12-13). We find the Examiner's reliance on the user metadata and system metadata in column 1 of Hsiao to evidence the storage of multiple types of metadata at each location of the content management systems and remote content managers as taught by Hsaio teaches the data for the claimed "an aggregated catalog that contains information including: (1) metadata identifying members' data objects residing in the data centers, and (2) metadata identifying members' data objects residing in the local storage of respective members computers," as recited in claim 1.

Since each of the content management systems and remote content managers each would have user metadata and system metadata, they would thereby have multiple metadatas to be used.

Appellants further argue the limitation "[c]ommunicating with the member computers to identify prescribed types of data objects newly stored in the member computers' local storage . . . " (Reply Br. 3). Appellants argue that:

> The Examiner argued that Hsiao discloses this feature, as Hsiao shows a content management system 10 connected to a network 20 that includes servers 25, 27 providing access to stored information (50, 55, 60) that may include links to other "locally stored" pages. [Ex. Answer: page 13]. Appellant[s] respectfully disagrees. The Examiner's argument is not persuasive because, as discussed above, Hsiao uses the term "local" in a manner that contrasts with the claim language.
> Furthermore, Hsiao's Figure 1 explicitly contradicts the Examiner's argument because Hsiao explicitly illustrates the Examiner's cited information (50, 55, 60) outside the user computers 37, 39. The Examiner's interpretation of Hsiao's "local" to mean "stored on the user computers 37, 39" does not find any support in Hsiao's text and drawings. Once it is understood that Hsiao's use of the term "local" is unrelated to the user computers 37, 39, the attempted reading (pages 13-14) of the claimed feature on Hsiao's disclosure falls apart.

(Reply Br. 3-4). We disagree with Appellants' position and find that the teachings of Hsiao are only exemplary and Hsiao teaches at column 8 that system 10 may be a stand alone database of documents. We find Hsiao supports the Examiner's position that the data would be "local." Therefore, we find Appellants' argument to be unavailing.

With respect to Appellants' argument concerning "[u]pdating the aggregated catalog to list the newly stored data objects from the online

data centers and member computers' local storage . . . " (Reply Br. 4),
Appellants rely upon the argument that the "'local content manager' 515 is a
component of the scalable content management system 10, which is clearly
apart from the client 505. [Hsiao: Fig. 5] [and] Hsiao's Figure 1 [shows] the
content management system 10 is separate from the user's computers 37
[and] 39." (Reply Br. 4).

Here, we note that Appellants' argument is not commensurate with the
Examiner's express correlation of the claim language to the teachings of
Hsiao wherein the Examiner has identified the scalable content manager and
the remote content manager as the member computer and data center
computer rather than the user's computers 37 and 39. Therefore, we find
Appellants' argument to be unpersuasive of error in the Examiner's showing
of obviousness.

It would appear that Appellants have a breath of claims issue, wherein
Appellants have elected to recite a broad term "member computer" which
has given the Examiner broader interpretation than the Appellants may have
desired. If Appellants desired to claim the end-user, then Appellants should
have recited "end-user" or alternatively recited required intermediary
processing and end-user computers which would have obviated the
Examiner's interpretation. But neither has been done and allowed the
Examiner a broad yet reasonable interpretation of the claim terms "member"
and "member computer."

With respect to Appellants' argument concerning "[r]esponsive to
each request by a member, searching the aggregated catalog and
utilizing results of the search to provide an output for display at the
requesting member's computer, the output comprising a consolidated

listing of both online data objects and locally stored data objects owned
by the requesting member . . . " (Reply Br. 4-5), Appellants argue that
"[a]ccordingly, Hsiao's single system view relates to a consolidated view of
all scalable content management systems (which Hsiao explicitly shows are
external to the user's computers), and lacks any relationship to data objects
residing on member's computers." (Reply Br. 4-5). Appellants merely
reiterate the language of the claim and provide an argument which is not
commensurate in scope with the language of the claim since there is no
recited "relationship." Therefore, we find Appellants' argument to be
unpersuasive of error in the Examiner's showing of obviousness. Since
Appellants have not set forth any persuasive showing of error in the
Examiner reasoned conclusion of obviousness, we will sustain the rejection
of independent claim 1 and claims 7 and 13 which Appellants have elected
to group with claim 1.

In the Appeal Brief, Appellants separately argue claims 4 and 10 as a
separate group. (App. Br. 21-24). Appellants argue that Johnson' 384 does
not show the limitations of dependent claim 4 since Johnson' 384 does not
show "display of the consolidated listing at the member's computer" and
"updating the display substantially in real time . . ." as claimed. (App. Br.
22). Appellants further argue that "there has been no suggestion or
motivation, either in the references themselves, or in the knowledge
generally available to one of ordinary skill in the art, to modify the reference
or to combine the reference teachings." (App. Br. 23). We find Appellants
attack the references individually and to summarily dismiss the Examiner's
line of reasoning for the combination since Appellants do not find an express
suggestion or motivation in the references. We find the Examiner's line of

reasoning for the combination to be reasonable in light of the Examiners stated correlation of the interpretation of the "member's computer." Therefore, we find Appellants' argument to be unpersuasive of error in the Examiner's showing of obviousness.

With respect to dependent claims 2 and 8, Appellants repeat the language of independent claim 1 and maintains that Kumamoto does not remedy the deficiency therein. (App. Br. 25). We find that Appellants' contention does not rise to the level of a separate argument for patentability and therefore we will group claims 2 and 8 as falling with the independent claim 1.

With respect to dependent claims 5 and 11, Appellants repeat the language of independent claim 1 and maintains that Johnson '839 does not remedy the deficiency therein. (App. Br. 25-26). We find that Appellants' contention does not rise to the level of a separate argument for patentability and therefore we will group claims 5 and 11 as falling with the independent claim 1.

V. CONCLUSION

For the aforementioned reasons, the Examiner has shown a sufficient reasoned conclusion of obviousness which Appellants have not shown error therein nor have Appellants presented evidence of non-obviousness.

VI. ORDER

We affirm the obviousness rejections of claims 1, 2, 4, 5, 7, 8, 10, 11, and 13.

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AFFIRMED

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